

REMARKS

In the office action dated June 21, 2005, the Examiner:

- objected to the drawings for failing to show every feature of the invention specified in the claims;
- rejected claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite;
- rejected claims 1-2 as being unpatentable over Runde in view of Fujita; and
- suggested that claim 3 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph.

After the entry of this amendment, the pending claims are: claims 1-3 and 6.

Specification and Drawings Amendments

The Examiner has objected to the drawings for failing to show every feature of the invention specified in the claims. The Examiner suggested that a flowchart with the controls to illustrate the claimed subject matter will vitiate the objection. In response, Applicants have added a flowchart FIG. 10 to the present application. Support for the flowchart can be found in paragraphs [0029]-[0039] of the specification. The specification is amended accordingly. A set of amended drawings is attached in Appendix A.

No new matter has been added.

Claim Rejections - 35 USC § 112

The Examiner has rejected claim 3 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the limitation of “the current throttle openness” lacks antecedent basis. This limitation has been amended to the limitation of “a change of a current throttle openness.” Support for the amendment can be found in paragraphs [0031] and [0069] of the specification. Applicants respectfully submit that the rejection has been addressed.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 1-2 under 35 U.S.C. 103(1) as being unpatentable over Runde in view of Fujita.

To establish a *prima facie* case of obviousness, three basic criteria must be met, namely:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to *modify* the reference or to *combine* reference teachings;
- 2) There must be a reasonable expectation of *success*; and
- 3) The prior art reference (or references when combined) must *teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.¹

Claim 1 is directed to a shift control method for a six-speed automatic transmission. The method includes at least two distinct steps: (i) performing a preceding shift control when disengagement components of a preceding shift stage and a final target shift stage are identical during skip shifting, then executing a one-stage skip shift control toward the final target shift stage when a set of required conditions is satisfied; and (ii) standing by for a predetermined time period without performing the preceding shift control when the disengagement components of the preceding shift stage and the final target shift stage are different during skip shifting, then performing a one-stage skip shift control toward the final target shift stage only if a set of required conditions are met.

The Examiner has acknowledged that Runde does not teach or suggest the second step of claim 1, i.e., standing by for a predetermined time when the disengagement components of the preceding shift stage and the final target shift stage are different during skip shifting. But the Examiner attempts to support the deficiencies of Runde using Fujita reference. For the reasons described below, Applicants respectfully disagree that Fujita teaches or suggests the second step.

According to Fujita (col. 7, lines 45-50), the second brake 23 has *already begun to slip to perform the 4-3 downshifting* (which corresponds to the step of performing a preceding shift control) when the 4-3 downshifting command is outputted. In other words, Fujita does not teach or suggest the step of *standing by for a predetermined time without*

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In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

performing the preceding shift control. Therefore, claims 1-2 are patentable over Runde in view of Fujita, as neither references teach or suggest at least the second step of claim 1.

New Claim

The Examiner has suggested that claim 3 would be allowable after overcoming the indefiniteness rejection under 35 U.S.C. 112, second paragraph, and re-written in an independent form including all limitation in the base claims. Accordingly, Applicants have added a new claim 6 to the present application, which includes all the limitations recited in claims 1 and 3. Support for claim 6 can be found in paragraphs [0029]-[0039] of the specification. No new matter has been added. Applicants respectfully submit that claim 6 is in condition for allowance.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at 650-843-7519 to set up such an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order no. 060945-0108-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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Appendix A

Please see the attachment.